

Applicant : Scott, Walter
Appl. No. : 10/644,105
Examiner : Gehman, Bryon
Docket No. : 14232.4001

Amendments to the Drawings

Attached herewith is replacement drawing sheet 1 of 5 which shows Fig. 1.

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REMARKS

Prior to this amendment, claims 1-16, 18, 20, 21, 23 and 24 were pending in this application. The same claims are pending after this Amendment and independent claims 1 and 10 have been amended. Applicant submits that the application is in condition for allowance for the following reasons.

Objection to the Drawings

Applicant previously submitted revised Figure 1 in which the components are illustrated in three dimensions, instead of partially in three dimensions and partially in two dimensions. Although the revised Figure 1 overcomes the three dimension issue, the Examiner now objects to the Figures for failing to show the “lumen 26 and top and bottom lids.” However, both the originally filed Figure 1 and the revised Figure 1 plainly illustrate lumen 26 (in which the subcontainer 30 and plant 52 are inserted), but because the reference numeral “26” is missing, applicant submits a further revised Figure 1 that adds reference numeral 26 to point to the lumen 26. The revised Figure 1 submitted on January 25, 2005 already depicts the top lid 22 and bottom lid 24. Therefore, the further revised Figure 1 is in proper condition for allowance. The addition of “26” to point to the lumen in Figure 1 does not constitute new matter because the lumen 26 was disclosed in the specification (see, e.g., paragraph 0009) and in originally filed Figure 1.

Rejection under Section 112

The Examiner rejected claims 1-16, 18, 20-21 and 23-24 as failing to satisfy the written description requirement of Section 112. Specifically, the Examiner states that the top and bottom lids 22, 24 were not disclosed in the drawings or specification. However, the specification does in

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fact disclose separate top and bottom lids 22, 24, as well as an integrated top and bottom option: “The top 22 and base 24 may be separate parts from the body 20, or one or both of the top and base may be integrally formed with the body 20.” See paragraph [0009]. Further, when focusing on the embodiment in which the top and bottom lids 22, 24 are separate from the body 20, the separated top and bottom lids 22, 24 permit one to insert the plant 52 and subcontainer 30 into the body 20, and to allow them to be removed from the body 20 for use in an aquarium or planter. In fact, other portions of the specification state: “The subcontainer 30 is then inserted into the lumen of the body 20 and the base 24 is attached to the body 20” and “the subcontainer 30 may be inserted into the lumen of the body 20 and slid down the lumen to rest on the base 24 of the body 20.” See paragraph [0011]. These containers are intended to be displayed at a retail store for purchase, whereupon the customer would remove the plant from the container at home. See optional card hook 60 in Figure 1. Therefore, applicants submit that the lumen 26 and top and bottom lids 22, 24 as required by the claims are disclosed in the specification and that the claims satisfy Section 112.

Rejection Under Section 103(a)

The Examiner rejected claims 1,6, 9-10, 18, 20 and 23-24 under Section 103(a) over Saul U.S. Patent No. 4,071,064 in view of Halleck U.S. Patent No. 3,314,194 and Dahlson U.S. patent application 2003/0047474. Claims 2-5 and 11-16 were rejected under Section 103(a) in further view of McKenzie U.S. Patent No. 3,973,355. Claim 7 was rejected under Section 103(a) in further view of Van Zyl U.S. Patent No. 4,075,786. Claims 8 and 21 were rejected under Section 103(a) in further view of Chadwick U.S. Patent No. 5,974,550.

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Independent claims 1 and 10 have been amended to reflect that the subcontainer of claim 1 slidably engages and is located entirely within the body lumen (e.g., lumen 26 of Figure 1) and the inner container of claim 10 engages the inner surface of and is entirely within the body lumen. Thus, these claims, as amended, essentially require a body, a subcontainer that slidably engages the body lumen (or a container that engages the inner surface of the main lumen in claim 10) to reside completely within the body lumen, a hydrogel contained in the subcontainer, a top lid on the body, a bottom lid on the body, and another lid or divider having a second lumen for the subcontainer. Because the subcontainer slides into and out of the body lumen, this combination exhibits the advantages expressed in applicant's Amendment dated January 25, 2005 for preventing damage to the plant when the plant is inserted or removed from the body lumen. Applicants respectfully submit that the pending claims as amended are distinguishable from each of these prior art references and their combination for these and the following reasons.

In making rejections, the Examiner has acknowledged various deficiencies in the prior art. For example, page 4 of the Office Action recognizes that Saul does not disclose the use of a hydrogel in a subcontainer or a lid that covers a subcontainer. The Examiner points to the little stand 1b in Saul as being a subcontainer. However, the little stand 1b is too small to hold any adequate amount of hydrogel and thus, one would be taught away from trying to put hydrogel into Saul's stand 1b. If the Examiner is unaware, the hydrogel typically used by applicant are in the form of chunks, like ice cubes, which are unlikely to fit in Saul's stand 1b. Further, if one were to add a lid on the stand 1b in Saul as suggested by the Examiner, one would also have to add a second lumen to the lid to accommodate the roots of the plant, another missing feature. In addition, the opening of

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Saul's little stand 1b is unlikely large enough to accommodate both the newly added hydrogel and the plant's roots. Also, as required by the amended claims, Saul does not disclose a subcontainer holding a hydrogel where the subcontainer slidably engages the body lumen or engages the inner surface of the body lumen. There simply is no express teaching or suggestion in the prior art references to add all four of the following modifications to Saul: (1) its little stand is enlarged a drastic amount so as to hold both hydrogel and a plant's growing roots, (2) the stand is enlarged so much that the stand slidably engages the inner surface of the lumen, (3) a lid is added to cover the stand, and (4) a second lumen is added in the lid of the stand to permit the plant's roots access to the hydrogel while at the same time, hindering the hydrogel from leaking out of the stand.

Similarly, Halleck is directed to a container 10 that has a hood or dome 40. Thus, Halleck does not disclose an inner container that slidably engages the outer container in order to reside completely within the outer container. If the hooded portion is considered to be another container, the bottom container 10 of Halleck is not completely within another container, as required by the claims. Also, as recognized by the Examiner, Halleck further lacks a hydrogel. Nor does Halleck disclose a removable top lid, much less the unique claimed combination of a dual container with the removable top lid, removable bottom lid, a hydrogel and a second lumen that provides access to the hydrogel and yet at the same time hinders the hydrogel from leaking out of the inner container.

In order to find references to read on the claims, the Examiner has to resort to picking and choosing structures from various different prior art references to arrive at the claimed combination, which resembles using impermissible hindsight to find particular structures in different prior art. Nor does the Examiner identify any sentence in the prior art that teaches or suggests this picking and

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choosing of pieces of the prior art to create the claimed combination. If the Examiner's approach to finding pieces of the claimed combination in the prior art were proper, each of the prior art patents Saul, Dahlson, Halleck and McKenzie, to name a few, would not have issued as patents because their individual structural pieces can be found in other prior art. The claims of the present application have already been amended a couple times to include further limitations that make the claims different than and distinguishable from the prior art references.

Claims 1 and 10 recite an inner container completely within an outer container, where the outer container has a removable top lid and a removable bottom lid, where the inner container also holds a hydrogel, the inner container engages the inner surface of the body lumen of the outer container, and there is a lumen in the top of the inner container through which the roots of the live plant gain access to the hydrogel while at the same time hindering the hydrogel from leaking out of the inner container. The cited prior art does not disclose all of these features. The cited prior art does not disclose an inner container completely within and slidably engaging an outer container with removable top and bottom lids, much less the entire combination of recited elements including the hydrogel in the inner container, an inner container that is slidably received in the outer container, and a lumen in the top of the inner container through which the roots of the live plant gain access to the hydrogel while at the same time hindering the hydrogel from leaking out of the inner container. These reasons alone suffice to distinguish the claims as amended over the cited prior art.

Therefore, none of the cited prior art disclose every limitation required by the claims. If the Examiner attempts to combine multiple references to cover all the claim limitations, such would be the use of impermissible hindsight to reconstruct the claims.

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Applicant submits that the dependent claims are patentable for at least the same reasons their independent claims are patentably distinct from the prior art. Thus, applicant's silence as to the Examiner's arguments regarding the dependent claims should not be considered applicant's acquiescence to the Examiner's views.

With respect to the dependent claims, there are additional grounds for patentability. The Examiner previously acknowledged that Dahlson lacks the tapered lumen of claims 2 and 12, for example, and resorted to Figures 10 and 11 of McKenzie to find use of a tapered lumen 30 or 20. However, McKenzie does not use a tapered lumen in a subcontainer, much less a tapered lumen to provide access to a hydrogel in a subcontainer. McKenzie merely shows a tapered lumen formed inside foam. Now, the Examiner agrees that Saul, Halleck and Dahlson are missing the tapered lumen for providing access to a hydrogel: "To modify the closed container system of Saul, Halleck and Dahlson employing the tapered lumen shape of McKenzie...." Office Action at p.4.

There are still additional reasons why the dependent claims 2-5 and 11-16 distinguish over McKenzie. First, McKenzie fails to disclose the claimed inner container within an outer container, an inner container slidably engaged to the outer container, an inner container large enough to hold hydrogel and the plant's roots, a removable top lid, a removable bottom lid, and a second lumen in the top of the inner container through which the roots of the live plant gain access to the hydrogel while at the same time hindering the hydrogel from leaking out of the inner container.

Second, McKenzie's lumen 30 or 20 is provided in a solid foam block, not in the top of a hollow inner container. McKenzie uses a solid foam block and thus, teaches away from the use of a hydrogel that can leak from one container into another container. McKenzie teaches the use of a

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tapered hole in a solid foam block to hold the flower, but applying this teaching to a hydrogel would result in creating a tapered hole in the hydrogel, not in a lid of an inner container.

Third, purpose of McKenzie's lumen is to hold a plant steady, whereas applicant's lumen serves to give the roots of the live plant access to the hydrogel while at the same time hindering the hydrogel from leaking out of the inner container.

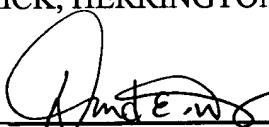
CONCLUSION

Applicant submits that the detailed amendments to the claims and Figure 1, and arguments thereto, place the application into condition for allowance. Prompt and favorable action on the merits of the claims is earnestly solicited. Should the Examiner have any questions or comments, the undersigned can be reached at (949) 567-6700.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

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